

## **REMARKS**

The above referenced patent application has been reviewed in light of the Office Action, dated August 22, 2007, in which:

- claims 1-9 are rejected under the judicially created doctrine of obvious-type (non-statutory) double patenting in reference to Holloway *et al.* (hereinafter ‘Holloway;’ US Patent No. 6,747,996) in view of Baker *et al.* (hereinafter ‘Baker;’ US Patent No. 6,661,811) and Rakib *et al.* (hereinafter ‘Rakib;’ US Patent No. 7,095,707); and
- claims 10-18 are also rejected under the judicially created doctrine of obvious-type (non-statutory) double patenting in reference to Holloway (US Patent No. 6,747,996) in view of Baker and Woodhead *et al.* (hereinafter ‘Woodhead;’ US Patent No. 5,640,388).

Reconsideration of the above referenced patent application in view of the following remarks is respectfully requested.

Claims 1-18 are now pending the above referenced patent application. No claims have been amended, cancelled, or added. No new matter has been entered.

## 1. 35 U.S.C. § 101

### *1.1. Non-Statutory Double Patenting: Claims 1-18*

The PTO has rejected claims 1-18 under the judicially created doctrine of obvious-type (non-statutory) double patenting. The PTO asserts that claims 1-18 claim the same invention as that of issued U.S. patent no. 6,747,996. In support of this, the PTO cites Baker, Rakib, and Woodhead.

It is respectfully noted that both Baker and Rakib were filed after the December 8, 1999 priority date of the current application (Ser. No. 10/828,687).

M.P.E.P. § 804.02(II) sets forth the standard for avoiding a non-statutory double patenting rejection (emphasis added):

804.02 Avoiding a Double Patenting Rejection

#### II. NONSTATUTORY

A rejection based on a nonstatutory type of double patenting can be avoided by filing a terminal disclaimer in the application or proceeding in which the rejection is made. In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Knohl, 386 F.2d 476, 155 USPQ 586 (CCPA 1967); and In re Griswold, 365 F.2d 834, 150 USPQ 804 (CCPA 1966). ...

The use of a 37 CFR 1.131 affidavit in overcoming a double patenting rejection is inappropriate because the claim or claims in the application are being rejected over a patent which claims the rejected invention. In re Dunn, 349 F.2d 433, 146 USPQ 479 (CCPA 1965). 37 CFR 1.131 is inapplicable if the claims of the application and the patent are "directed to substantially the same invention." It is also inapplicable if there is a lack of "patentable distinctness" between the claimed subject matter. Knell v. Muller, 174 USPQ 460 (Comm'r. Pat. 1971), citing the court decisions in In re Ward, 236 F.2d 428, 111 USPQ 101 (CCPA 1956); In re Teague, 254 F.2d 145, 117 USPQ 284 (CCPA 1958); and In re Hidy, 303 F.2d 954, 133 USPQ 65 (CCPA 1962).

A patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term of a patent. 35 U.S.C. 253. The statute does not provide for a terminal disclaimer of only a specified claim or claims. The terminal disclaimer must operate with respect to all claims in the patent.

**The filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection.** Quad Environmental Technologies Corp. v. Union Sanitary District, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). The court indicated that the "**filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection.**"

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Assignee has filed a terminal disclaimer as part of this response. Assignee hereby disclaims the terminal portion of the statutory term of any patent granted on the current application which would extend beyond the expiration date of the full statutory term of U.S. patent 6,747,996, as described in detail the attached terminal disclaimer document. It is respectfully requested that the foregoing claim rejections be withdrawn.

## **CONCLUSION**

In view of the foregoing, it is respectfully asserted that all claims pending in this application, as amended, are in condition for allowance. If the Examiner has any questions, they are invited to contact the undersigned at 202-470-6450. Reconsideration of this patent application and early allowance of all claims is respectfully requested.

Respectfully submitted,

/Justin B. Scout, Reg. No. 54,431/  
Justin B. Scout  
Reg. No. 54,431

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Brake Hughes Bellermann LLP  
1700 Pennsylvania Avenue, NW, Suite 400  
Washington, DC 20006

202.470.6450 tel.  
202.470.6464 fax